

**Atty's Docket: Beiersdorf 540.1-wcg**

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

**ADDITIONAL FEES**

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

**REMARKS**

Claims 1, 3,5-6, and 9-13 are pending in the application. Claims 1 and 13 have been amended.

The amendments to claim 1 specify that the claimed eyepatch is elastic, and that the foam layers are comprised of aqueous aliphatic dispersions.

The amendments to claim 13 reflects these elements in the method step.

**Response to Examiner's Advisory Action**

Examiner states in the advisory action of 9 December 2003 that "a recitation of different dimensions and properties of the patch that does not perform differently from the prior art patch does not make patentable distinction from the prior art patch." Advisory action, continuation sheet.

In response, Applicants point out that the claimed patch comprising the three-layered foam assembly does indeed perform differently from the prior art, as well as having a distinct composition.

1. Neither Morgan nor Sandvig specify that their foam compositions comprise aqueous aliphatic dispersions of polyesterurethanes. Neither is there any disclosure

**Atty's Docket: Beiersdorf 540.1-wcg**

supporting a conclusion that the prior art patches have the same properties, i.e., perform identically to the claimed eyepatch.

Morgan simply refers to an "elastic or flexible foam intermediate." No composition or method of preparing is disclosed.

Sandvig discloses layers of "chemically blown foam." Col. 2, lines 30. The only polymer disclosed for use in the foam is polyvinyl chloride. Col. 2, line 52. Thus, Sandvig explicitly discloses a chemically blown foam of polyvinyl chloride.

It is not reasonable to suggest that either a chemically blown foam of polyvinyl chloride, or a non-descript elastic foam layer can render obvious the tri-partite foam assembly of aqueous dispersions of polyurethanes.

Therefore, the rejection of claim 1 should be withdrawn because the references do not teach all claim limitations. MPEP § 2143.03

2. As demonstrated on pages 5-8 of the specification, the physical properties of the claimed eyepatch are disclosed. Thus, the assembly of foam layers provide a very thin layer of about 1mm or less. Yet the patch is elastic to the point that it may be elongated over 4 times its original transverse and /or lengthwise dimensions before the material fails; i.e., tear or fragment. This has been achieved while providing for very good air and water permeability.

There is not any indication that the patches of Sandvig or Morgan can approximate these highly desirable properties.

Should Examiner believe that the prior patches inherently possess these properties, she is reminded that a *prima facie* case of inherency requires that the prior art necessarily have the same properties. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

**Att'y's Docket: Beiersdorf 540.1-wcg**

necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (Emphasis added). MPEP § 2112.

In the present case, the claims specifically recite a foam composition not disclosed or suggested in the references. Therefore, relying on a theory of inherency to reject the claims is not proper.

For this reason alone, the rejection under § 103(a) should be withdrawn.

3. The rejections should also be withdrawn because the references do not provide for an enabling disclosure that would lead person's in the art to achieve the claimed eyepatch or the method of claim 13.

It is well established that a proper reference under 35 USC §§102 or 103 must be enabling in the sense of 35 USC § 112, paragraph 1. It is suggested that the Morgan and Sandvig references are not enabling to that extent. Pertinent is the following quote from *In re Le Grice*, 133 USPQ 365, 374 (CCPA 1962):

The proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains *could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention* on which a patent is sought." [Emphasis added]

See also, *In re Hoeksema*, 158 USPQ 596, 601 (CCPA 1968), wherein the Court stated:

"While *In re Le Grice* was bottomed on an issue arising under 35 U.S.C. 102 where the reference was a 'printed publication,' that test, in our view, is also properly applicable to issues arising under 35 U.S.C. 103."

**Atty's Docket: Beiersdorf 540.1-wcg**

Applicants respectfully point out that it is not reasonable to maintain the rejections in view of Morgan and Sandvig because they provide virtually no guidance in preparing their own patch, let alone Applicants'. They provide absolutely no methodology or suggestion to guide persons of ordinary skill in the art to achieve the claimed eyepatch.

In this regard, proper weight must be given the quantitative data presented in the specification and described above. "Objective evidence or secondary considerations such as unexpected results ... are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence." MPEP § 2141

Sandvig and Morgan do not recite the same composition, or the same layer assembly. The relevance of this is that Sandvig and Morgan do not show how to achieve Applicants' eyepatch.

A closer look at the Sandvig and Morgan references indicates that these inventors were focusing on the use of a new kind of hydrocolloidal adhesive. Even then, Sandvig does not describe it, but only mentions the trade name, Duoderm. As an aside, although Duoderm is an adhesive, it does not have polyurethane in it; instead, it is a polyisoprene-based adhesive that gels when contacted with moisture.

**CONCLUSION**

In conclusion, Sandvig or Morgan do not render the claims obvious.

The amended claims recite an eyepatch having distinct composition, dimensions and properties. These properties inherently result from the manner of

**Atty's Docket: Beiersdorf 540.1-wcg**

how the patch is made, thus, each and every property need not be recited in the claims.

Allowance of the claims is respectfully solicited.

Respectfully Submitted,

Norris, McLaughlin & Marcus  
220 East 42 nd Street  
New York, NY 10017  
Telephone (212) 808-0700  
Facsimile (212) 808-0844

  
Theodore Gottlieb, PhD  
Reg. No. 42, 597

**Certificate of Transmission**

I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office (Fax No. (703) ~~512~~ 9307

on 20-JAN-04  
(Date)

  
Typed or printed name of transmitter

Signature 